

## **REMARKS**

### **I. Status of the Claims**

Claims 1-6 are currently pending and stand rejected in this application. Without prejudice or disclaimer, claim 1 has been amended herein. Applicants submit that the above amendment raises no issue of new matter.

### **II. Rejections under 35 U.S.C. § 102(b)**

#### **A. U.S. Patent No. 5,462,683 to Kinoshita et al.**

The Examiner maintains the rejection of claims 1, 3 and 6 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,462,683 to Kinoshita (Kinoshita I). See Office Action at 2. Applicants respectfully disagree and traverse the rejection in view of the reasons of record and the following reasons.

As amended, claim 1 recites “[a] grease composition **consisting essentially of** a lubricating base oil combined with (A) 2-30 wt% of a thickener, (B) 0.1-10 wt% of at least one type of compound selected from . . . (C) at least one extreme pressure agent chosen from . . . and (D) at least one rust inhibitor chosen from . . . .” *Id.* Applicants again point out that, “[t]he transitional phrase ‘consisting essentially of’ limits the scope of a claim to the specified materials or steps ‘and those that do not materially affect the basic and novel characteristic(s)’ of the claimed invention.” M.P.E.P. § 2111.03 8<sup>th</sup> Edition, August 2007 Revision (citing *In re Herz*, 537 F.2d 549, 551-52, (CCPA 1976)).

The Examiner continues to ignore the fact that the compositions of Kinoshita I, which require boron nitride powders, cannot anticipate the grease composition of the claimed invention because boron nitride powders do not fall within the scope of a “consisting essentially of” claim.

Further, solely in the interest of advancing prosecution, Applicants have amended claim 1 herein to delete “dihydrocarbyl polysulfides.”

Accordingly, the compositions disclosed in Kinoshita I do not anticipate claims 1, 3 and 6 of the claimed invention and Applicants respectfully request withdrawal of the rejection.

**B. U.S. Patent No. 5,516,439 to Takeuchi et al.**

The Examiner maintains the rejection of claims 1-3 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,516,439 to Takeuchi (Takeuchi). Office Action at 2. The Examiner contends that Takeuchi teaches “that the metal salts is an *optional* component of the composition, and the compositions of Takeuchi meet the limitations of claims 1-3 in the case where the metal salt is not present.” *Id.* Applicants respectfully disagree and traverse the rejection based on the following reasons.

As an initial matter, claim 1 as-amended, now recites, *inter alia*, that the grease compositions consist essentially of “at least one rust inhibitor, chosen from metal soaps, polyhydric alcohol partial esters, amines, phosphoric acid and phosphoric acid salts.” *Id.* Thus, the rust inhibitors are required components of the

claimed grease compositions, as opposed to merely optional compounds in Takeuchi.

Moreover, the Examiner improperly relies on *optional* ingredients in Takeuchi to support the § 102 rejection. A rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. M.P.E.P. § 706.02. The identical invention must be described in as complete detail as is contained in, and must be arranged or combined in the same way as recited in the claim. See *Net MoneyIn, Inc. v. Verisign, Inc.*, Slip. Op. No. 2007-1565 at 15-16 See also M.P.E.P. § 2131. In order to identically describe or disclose the claimed composition, the reference must direct those skilled in the art to the composition without any need for picking and choosing from a plurality of ingredients in the reference. *Azko v. U.S. International Trade Commission*, 808 F.2d 1471, 1480 (ed. Cir. 1986) (citing *In re Arkley*, 455 F.2d 586, 587, 172 USPQ 524, 526 (CCPA 1972)). “[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102.” Thus, the Examiner is improperly picking and choosing certain elements present in Takeuchi to support the rejection under § 102. For at least these reasons, Takeuchi fails to anticipate claims 1-3, and Applicants respectfully request withdrawal of the rejection.

**C. U.S. Patent No. 5,569,643 to Kinoshita et al.**

The Examiner rejects claims 1 and 4-6 under 35 U.S.C. § 102(b) over U.S. Patent No. 5,043,085 to Kinoshita et al. (Kinoshita II). See Office Action at 3-4. The

Examiner claims, in response to Applicants' arguments submitted in the Response of July 17, 2008, that Kinoshita II fails to disclose in its compositions, the use of specific rust inhibitors or extreme pressure agents presently recited in amended claim 1, that "the rust inhibitors and extreme pressure agents are optional components." *Id.* at 3-4. As-amended, claim 1 now recites both extreme pressure agents and rust inhibitors as required components in its claimed grease compositions. Thus, because Kinoshita II does not disclose the use of rust inhibitors and only optionally discloses extreme pressure agents, Kinoshita II does not anticipate claims 1 and 4-6 of the present invention and Applicants respectfully request its withdrawal.

### III. Conclusions

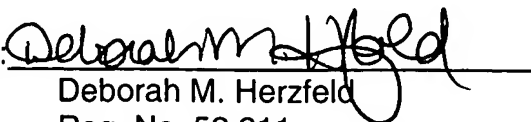
In view of the foregoing amendment and remarks, Applicants request reconsideration of the application and the timely allowance of the pending claims.

If there is any fee due in connection with the filing of this Preliminary Amendment, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 16, 2008

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